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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,442	11/15/2001	Michael J. Harrison	924.1.055	3551

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EXAMINER

BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
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3764

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DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/002,442

Applicant

Michael Harrison et al

Examiner

Michael Brown

Group Art Unit

3764

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 1-9 is/are allowed.
- ☒ Claim(s) 10, 12-14 is/are rejected.
- ☒ Claim(s) 11-9-2 15-20 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received In Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2-4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Tseng '289.

Tseng discloses a condom (col. 10, lines 39) and a first lubricating gel (col. 2, lines 25-32), having an effective amount of at least one male genitalia desensitizing agent (polyethylene glycol) the first lubricant has a viscosity in the range of 10,000 cps to 75000 cps (col. 2, lines 31-34, 37000 –74000 cps is in the range of 10,000 cps to 75,000 cps).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tseng in view Harmon, along with Kelly.

Tseng disclose a condom having a first lubricating agent, substantially as claimed that further comprises a cps between 10,000 cps to 25,000 cps (col. 11, table 5). However, Tseng does not disclose the condom being rolled down and inserted into

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a foil package or the lubricant being on the closed end of the condom. Harmon teaches in figures 1-6 a condom 10, comprising a lubricant 22 that is on the closed end of the condom. The condom is rolled down and inserted inside of a package (fi.6). Kelly teaches a condom package 14 made of foil. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the condom disclosed by Tseng could be rolled down with a lubricant on the closed end as taught by Harmon in order to keep the closed end lubricated while the condom is inside of the package. The package could be made of foil as taught by Kelly in order to protect the condom and the lubricant.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 12 above, and further in view of Terry.

Terry teaches the concept of using benzocaine (col. 15, lines 11) in a lubricant that can be applied to a condom (col. 10, line 64). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that benzocaine as taught by Terry could be used in the lubricating agent disclosed by Tseng and taught by Harmon in order to use it to prevent microorganism that might be inside of the condom from enter the male's urethra while wearing the condom.

***Allowable Subject Matter***

Claims 11 and 15-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-9 are allowed.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kross, Lubbs and Pugh, each disclose a condom with a lubricant. Although each of the references discloses structural limitations recited in the claims, neither could be used to reject any claims, in the first office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 703-308-2682. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 703-308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Brown  
March 19, 2004



**MICHAEL A. BROWN  
PRIMARY EXAMINER**